REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 1, 2004. Upon entry of the amendments in this response, claims 96 – 104 and 118 – 133 remain pending. In particular, Applicants amend claims 96 – 104, add new claims 118 – 133, and cancel claims 109 – 117 without prejudice, waiver, or disclaimer. Applicant cancels these claims merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested. In addition, Applicant does not intend to make any admissions regarding any other statements in the Office Action that are not explicitly referenced in this response.

I. Priority

The Office Action states that Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged and that the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 96 – 104 and 109 – 117 of this application. Applicants, however, respectfully traverse this assertion. Applicants asserts that the provisional application upon which priority is claimed provides adequate support under 35 U.S.C. §112 for claims 96, 97, 99, 100, 101, 109, 111, 112, 113, and 116. While Applicants cancel claims 109 – 117, Applicants address claims 109, 111, 112, 113, and 116 to expedite prosecution in the event of future confusion. With regard to:

Claim 96: Applicants refer to page 3, under the "Promotional ¼ Screen a/v" section. Also see page 4, under the "Screen Saver" section, and under the "Updatable screen graphics and arts" section. Further Applicants refer to page 13, which illustrates "graphics areas" for

displaying promotional motion video presentations.

Claim 97: Applicants refer to page 13, which illustrates "graphics areas" for displaying promotional motion video presentations.

Claim 99: Applicants refer to page 2, under the "The present invention includes elements such as the following" section.

Claim 100: Applicants refer to page under the under the "Promotional ¼ Screen a/v" section.

Claim 101: Applicants refer to page under the "Promotional ¼ Screen a/v" section.

Claim 109: Applicants refer to page 3, under the "Promotional ¼ Screen a/v" section. Also see page 4, under the "Screen Saver" section. Further Applicants refer to page 13, which illustrates "graphics areas" for displaying promotional motion video presentations.

Claim 111: Applicants refer to page 13, which illustrates "graphics areas" for displaying promotional motion video presentations.

Claim 112: Applicants refer to page 2, under the "The present invention includes elements such as the following" section.

Claim 113: Applicants refer to page 3, under the "Promotional ¼ Screen a/v" section.

Claim 116: See page 40, under QAM and QPSK headings, respectively.

II. Rejections Under 35 U.S.C. §112

The Office Action indicates that claims 103 and 116 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. However, Applicants amend claim 103 and cancel claim 116. Applicants submit that claim 103, as amended is patentable in light of 35 U.S.C. §112.

III. Rejections Under 35 U.S.C. §102

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

A. Claim 96 is Patentable Over *Thomas*

The Office Action indicates that claim 96 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. publication number 2003/0037068 to Thomas ("*Thomas*"). In response, Applicants amend claim 96 to now recite:

> A television set-top terminal ("STT") coupled to a server via a bi-directional communication network, said STT comprising:
> memory having program code stored therein;
> at least one processor that is programmed by the program code to enable the STT to:
> receive first data, wherein at least a portion of the first data corresponds to a media guide for on-demand video presentations;
> receive second data, the second data being different than the first data, wherein at least a portion of the second data corresponds to merchandise advertising data, wherein the second data is received separately from the first data;
> provide a media guide presentation to a user via a television signal, wherein said media guide presentation comprises at least a portion of the first data, wherein at least a portion of the first data corresponds to a plurality of on-demand video presentations and wherein at least a portion of the second data corresponds to at least one merchandise advertising;
> receive user input corresponding to a selection of one of the plurality of on-demand video presentations in the media guide presentation; and
> responsive to the user input:
> establish a dedicated network session with the server for receiving said one of the plurality of video presentations;
> receive said one of the plurality of video presentations over the dedicated network session; and
> provide said one of the plurality of video presentations to the user.

Applicant submits that *Thomas* fails to disclose, teach, or suggest all of the limitations of claim 96, as amended. For at least this reason Applicants submit claim 96, as amended is patentable over *Thomas*.

B. Claim 109 is Patentable Over Thomas, *et al.*

The Office Action indicates that claim 109 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. publication number 2003/0037068 to Thomas ("*Thomas*"). For at least the reason that Applicants cancel claim 109, a discussion regarding the patentability of this claim is omitted.

IV. Rejections Under 35 U.S.C. §103

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, "[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

A. Claims 96 – 103 are patentable over *White*

1. Claim 96 is Patentable Over *White*

The Office Action indicates that claim 96 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,628,302 to White ("*White*"). In response, Applicants amend claim 96, as indicated above. For at least the reason that *White* fails to disclose, teach, or suggest all of the limitations of claim 96, as amended, Applicants submit claim 96, as amended is patentable over *White*.

In addition, the Office Action also states "[t]he examiner takes Official Notice the existence of commercial and/or promotion messages that comprise 'motion video presentations' is common knowledge in the art that is capable of instant and unquestionable demonstration as being well-known" (OA p. 6, last para.). Applicants respectfully traverse this rejection, and statement of Official Notice for at least the reason that the noticed fact is not capable of instant and unquestionable demonstration as being well-known. Applicants assert that the basis for the finding (in addition to the finding itself) does not include specific factual findings predicated on sound technical and scientific reasoning to the support the conclusion (as required), evidencing it not being well-known. As such, a statement of Official Notice is unwarranted. As recited in MPEP §2144.03(A), "it [is] not...appropriate for the Office Action to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." For at least these reasons, Applicants respectfully traverse the Office Action's statement of Official Notice.

2. Claim 103 is Patentable Over *White*

The Office Action indicates that claim 103 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,628,302 to White ("*White*"). The Office Action recites that

> [t]he examiner takes Official Notice that the particular usage of a 'first and second communication channel' wherein 'said first communication channel utilizes a quadrature phase shift keying (QPSK) and the second communication utilizes a quadrature amplitude modulation (QAM) is notoriously well known in the art of video distribution. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize both QAM and QPSK channels for purposes of facilitating the delivery of 'merchandising data' given the inherent advantages associated with each including the capability of being able to send and receive merchandising data though both in-band and out-of-band tuning (OA p. 8 last full para.).

Applicants respectfully traverse this rejection, and statement of Official Notice for at least the reason that the noticed fact is not capable of instant and unquestionable demonstration as being well-known.

Applicants assert that the basis for the finding (in addition to the finding itself) does not include specific factual findings predicated on sound technical and scientific reasoning to the support the conclusion (as required), evidencing it not being well-known. As such, a statement of Official Notice is unwarranted. As recited in MPEP §2144.03(A), "it [is] not...appropriate for the Office Action to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." For at least these reasons, Applicants respectfully traverse the Office Action's rejection and statement of Official Notice. Also, "If such notice is taken, the basis for such reasoning must be set forth explicitly. The Office Action must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion

of common knowledge."

In addition, Applicants amend claim 103, as noted above and assert that the above cited Official Notice is moot. For at least these reasons, Applicants respectfully traverse the Office Action's rejection and statement of Official Notice.

3. Claim 109 is Patentable Over *White*

The Office Action indicates that claim 109 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,628,302 to White ("*White*"). Applicants cancel claim 109, and submit that this rejection is now moot.

In addition, the Office Action states "[t]he examiner takes Official Notice the existence of commercial and/or promotion messages that comprise 'motion video presentations' is common knowledge in the art that is capable of instant and unquestionable demonstration as being well-known" (OA p. 6, last para.). Applicants respectfully traverse this statement of Official Notice for at least the reason that the noticed fact is not capable of instant and unquestionable demonstration as being well-known.

Applicants assert that the basis for the finding (in addition to the finding itself) does not include specific factual findings predicated on sound technical and scientific reasoning to the support the conclusion (as required), evidencing it not being well-known. As such, a statement of Official Notice is unwarranted. As recited in MPEP §2144.03(A), "it [is] not...appropriate for the Office Action to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." For at least these reasons, Applicants respectfully traverse the Office Action's statement of Official Notice.

4. Claims 97 – 103 are Patentable Over *White*

In addition, dependent claims 97 – 103 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 96. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

B. Claim 104 is Patentable Over *White, further in view of Wang*

The Office Action indicates that claim 104 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *White* in view of U.S. patent number 6,675,385 to Wang ("*Wang*"). Dependent claim 104 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 96. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 96 – 104 and 118 – 133 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

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